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| EXAMINER | |
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| MORGAN, ROBERT W | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3626 | |

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/556,945 | MARKS, JAMES D. | |
| | Examiner | Art Unit | |
| | Robert W. Morgan | 3626 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *13 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *151-203* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *151-203* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/13/05 has been entered.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 151-155, 157-158, 187-188, 191-192, 194-197 and 199-203 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,991,731 to Colon et al., "Web links cancer patients to drug trials" by Machlis and in view of "GO Network™ and drkoop.com Strike Exclusive $57 Million Cross-Network Partnership" by PR Newswire.

As per claim 151, Colon et al. teaches an Internet-networked system with online communication to a computing center from a large number of clinical study investigators at numerous and diverse locations remote from the computing center (see: column 1, lines 36-38). In additions, the system handles automatic assignment and randomization of thousands of participants in a clinical study with respect to care strategies to be administered to the study participants (see: column 1, lines 48-51). Furthermore, the system captures data in its database

through appropriate input forms developed for the specific clinical study and the data is stored online and reports are produced in real time to study investigators and to the sponsor regarding sites that are participating, recruitment levels by participating site, patient follow-up, and significant events (see: column 1, lines 64 to column 2, lines 4). Additionally, Colon et al. teaches computer system (17, 18, 19, Fig. 1) with a screen that brings up a form used for entering patient related data such as identification, demographics and medical conditions and later transmitted to the study management center (10, Fig. 1) as represented by input block (61, Fig. 5) (see: column 6, lines 22-30).

Colon et al. fails to teach the claimed electronic consent to an agreement volunteering for consideration as a member of a pool of potential candidates for review and selection for the clinical trials, the individual being the potential candidate and adding the at least one of the individual's information to a database of at least one individual available for consideration as a potential candidate for the clinical trials.

Machlis teaches a medical management company American Oncology Resources, Inc. (AOR) that helps its doctor participating in drug trials using web-based application and databases (see: paragraph 8). Machlis further teaches that each time (AOR) learns of a new drug trial the information about the trial is entered in the system and patient information stored in the database is scanned for preliminary matches (see: paragraph 10). Machlis also teaches TVisions, Internet consulting firm and working with AOR have developed a database for clinical drug trials. Furthermore, Machlis teaches that the patient can decide if they want to try a new therapy (see: paragraph 11). In addition, Machlis teaches for security and privacy reasons, all information

going in and out of the database is encrypted and only a patient initials and identification number are entered into the database which is accessed over the Internet (see: paragraph 12).

One of ordinary skill in art at the time the invention was made would have found it obvious to include (AOR) and TVisions web-based application and databases for drug trials with patient consent as taught by Machlis within the method for managing data used in conducting clinical studies as taught by Colon et al. with the motivation the making the process of linking data about patients and drug tests simple (see: Machlis: paragraph 2).

Colon and Machlis fail to teach the individual being the potential candidate giving electronic consent.

PR Newswire teaches that Infoseek Corporation home of GO Network agreed to partner with drkoop.com at the Go.com Health Center to provide opportunities for users to enroll in clinical trials from within GO Health (see: abstract). The Examiner considers the user to be the individual and the potential candidate.

Therefore, it would have been obvious to a person of ordinary skill in the art at time the invention was made to include using the Internet for user enrollment as taught by PR Newswire with the system as taught by Colon and Machlis with the motivation of giving users across multiple sites reliable health information benefiting from decades of medical experience offered by drkoop.com (see: abstract).

As per claim 152, Colon et al. teaches a computer system (17, 18, 19, Fig. 1) (reads on "enrollment interface and plurality of remote computer terminals") with a screen that brings up a form used for entering patient related data such as identification, demographics and medical conditions and later transmitted to the study management center (10, Fig. 1) as represented by

input block (61, Fig. 5) (see: column 6, lines 22-30). Colon et al. further teaches the use of Internet server (13, Fig. 1) used to provide Internet network service to all authorized users (see: column 3, lines 24-44). Additionally, Colon et al. teaches computer system (17, 18, 19, Fig. 1) with a screen that brings up a form used for entering patient related data such as identification, demographics and medical conditions and later transmitted to the study management center (10, Fig. 1) as represented by input block (61, Fig. 5) (see: column 6, lines 22-30).

Colon et al. fails to teach receiving electronic consent to the agreement and adding at least one piece of medical information to a database of individuals available for enrollment in the clinical trails.

Machlis teaches a medical management company American Oncology Resources, Inc. (AOR) that helps its doctor participating in drug trials using web-based application and databases (see: paragraph 8). Machlis further teaches that each time (AOR) learns of a new drug trial the information about the trial is entered in the system and patient information stored in the database is scanned for preliminary matches (see: paragraph 10). Machlis also teaches TVisions, Internet consulting firm and working with AOR have developed a database for clinical drug trials. Furthermore, Machlis teaches that the patient can decide if they want to try a new therapy (see: paragraph 11). In addition, Machlis teaches for security and privacy reasons, all information going in and out of the database is encrypted and only a patient initials and identification number are entered into the database which is accessed over the Internet (see: paragraph 12).

The obviousness of combining the teachings of Machlis within Colon et al. has been discussed in the rejection of claim 151, and incorporated herein.

As per claim 153, Colon et al. teaches an Internet-networked system with online communication to a computing center from a large number of clinical study investigators at numerous and diverse locations remote from the computing center (see: column 1, lines 36-38). In additions, the system handles automatic assignment and randomization of thousands of participants in a clinical study with respect to care strategies to be administered to the study participants (see: column 1, lines 48-51). Furthermore, the system captures data in its database through appropriate input forms developed for the specific clinical study and the data is stored online and reports are produced in real time to study investigators and to the sponsor regarding sites that are participating, recruitment levels by participating site, patient follow-up, and significant events (see: column 1, lines 64 to column 2, lines 4). Additionally, Colon et al. teaches a computer system (17, 18, 19, Fig. 1) with a screen that brings up a form used for entering patient related data such as identification, demographics and medical conditions and later transmitted to the study management center (10, Fig. 1) as represented by input block (61, Fig. 5) (see: column 6, lines 22-30).

Colon et al. fails to teach the claimed electronic consent by an individual at a computer terminal for consideration as a potential candidate for the clinical trials, the individual being the potential candidate and adding at least one piece of information for the individual to a database of at least one individual available for consideration as a potential candidate for the clinical trials.

Machlis teaches a medical management company American Oncology Resources, Inc. (AOR) that helps its doctor participating in drug trials using web-based application and databases (see: paragraph 8). Machlis further teaches that each time (AOR) learns of a new drug trial the information about the trial is entered in the system and patient information stored in the database

is scanned for preliminary matches (see: paragraph 10). Machlis also teaches TVisions, Internet consulting firm and working with AOR have developed a database for clinical drug trials. Furthermore, Machlis teaches that the patient can decide if they want to try a new therapy (see: paragraph 11). In addition, Machlis teaches for security and privacy reasons, all information going in and out of the database is encrypted and only a patient initials and identification number are entered into the database which is accessed over the Internet (see: paragraph 12).

The obviousness of combining the teachings of Machlis within Colon et al. has been discussed in the rejection of claim 151, and incorporated herein.

Colon and Machlis fail to teach the individual being the potential candidate giving electronic consent.

PR Newswire teaches that Infoseek Corporation home of GO Network agreed to partner with drkoop.com at the Go.com Health Center to provide opportunities for users to enroll in clinical trials from within GO Health (see: abstract). The Examiner considers the user to be the individual and the potential candidate.

The obviousness of combining the teachings of PR Newswire with the system of Colon and Machlis are discussed the rejection of claim 151, and incorporated herein.

As per claim 154, Colon et al. teaches the use of Internet server (13, Fig. 1) used to provide Internet network service to all authorized users (see: Colon et al.: column 3, lines 24-44). Colon et al. teaches an Internet-networked system with online communication to a computing center from a large number of clinical study investigators at numerous and diverse locations remote from the computing center (see: column 1, lines 36-38). In additions, the system handles automatic assignment and randomization of thousands of participants in a clinical study with

respect to care strategies to be administered to the study participants (see: column 1, lines 48-51). Furthermore, the system captures data in its database through appropriate input forms developed for the specific clinical study and the data is stored online and reports are produced in real time to study investigators and to the sponsor regarding sites that are participating, recruitment levels by participating site, patient follow-up, and significant events (see: column 1, lines 64 to column 2, lines 4). Additionally, Colon et al. teaches computer system (17, 18, 19, Fig. 1) with a screen that brings up a form used for entering patient related data such as identification, demographics and medical conditions and later transmitted to the study management center (10, Fig. 1) as represented by input block (61, Fig. 5) (see: column 6, lines 22-30).

Colon et al. fail to teach the claimed receiving an individual's online electronic consent to an agreement volunteering for consideration as a potential candidate for the clinical trials and adding at least one piece of information for the individual to a database for consideration as a potential candidate for the clinical trials.

Machlis teaches a medical management company American Oncology Resources, Inc. (AOR) that helps its doctor participating in drug trials using web-based application and databases (see: paragraph 8). Machlis further teaches that each time (AOR) learns of a new drug trial the information about the trial is entered in the system and patient information stored in the database is scanned for preliminary matches (see: paragraph 10). Machlis also teaches TVisions, Internet consulting firm and working with AOR have developed a database for clinical drug trials. Furthermore, Machlis teaches that the patient can decide if they want to try a new therapy (see: paragraph 11). In addition, Machlis teaches for security and privacy reasons, all information

going in and out of the database is encrypted and only a patient initials and identification number are entered into the database which is accessed over the Internet (see: paragraph 12).

The obviousness of combining the teachings of Machlis within Colon et al. has been discussed in the rejection of claim 151, and incorporated herein.

Colon and Machlis fail to teach the individual being the potential candidate giving electronic consent.

PR Newswire teaches that Infoseek Corporation home of GO Network agreed to partner with drkoop.com at the Go.com Health Center to provide opportunities for users to enroll in clinical trials from within GO Health (see: abstract). The Examiner considers the user to be the individual and the potential candidate.

The obviousness of combining the teachings of PR Newswire with the system of Colon and Machlis are discussed the rejection of claim 151, and incorporated herein.

As per claim 155, Colon et al. teaches a computer system (17, 18, 19, Fig. 1) (reads on "enrollment interface and plurality of remote computer terminals") with a screen that brings up a form used for entering patient related data such as identification, demographics and medical conditions and later transmitted to the study management center (10, Fig. 1) as represented by input block (61, Fig. 5) (see: column 6, lines 22-30). Colon et al. further teaches the use of Internet server (13, Fig. 1) used to provide Internet network service to all authorized users (see: column 3, lines 24-44). Additionally, Colon et al. teaches computer system (17, 18, 19, Fig. 1) with a screen that brings up a form used for entering patient related data such as identification, demographics and medical conditions and later transmitted to the study management center (10, Fig. 1) as represented by input block (61, Fig. 5) (see: column 6, lines 22-30).

Colon et al. fails to teach receiving electronic consent to the agreement and adding at least one piece of medical information to a database of individuals available for enrollment in the clinical trails, each of the individuals being of the potential candidate.

Machlis teaches a medical management company American Oncology Resources, Inc. (AOR) that helps its doctor participating in drug trials using web-based application and databases (see: paragraph 8). Machlis further teaches that each time (AOR) learns of a new drug trial the information about the trial is entered in the system and patient information stored in the database is scanned for preliminary matches (see: paragraph 10). Machlis also teaches TVisions, Internet consulting firm and working with AOR have developed a database for clinical drug trials. Furthermore, Machlis teaches that the patient can decide if they want to try a new therapy (see: paragraph 11). In addition, Machlis teaches for security and privacy reasons, all information going in and out of the database is encrypted and only a patient initials and identification number are entered into the database which is accessed over the Internet (see: paragraph 12).

The obviousness of combining the teachings of Machlis within Colon et al. has been discussed in the rejection of claim 151, and incorporated herein.

Colon and Machlis fail to teach each of the individuals being one of the potential candidates giving electronic consent.

PR Newswire teaches that Infoseek Corporation home of GO Network agreed to partner with drkoop.com at the Go.com Health Center to provide opportunities for users to enroll in clinical trials from within GO Health (see: abstract). The Examiner considers the user to be the individual and the potential candidate.

The obviousness of combining the teachings of PR Newswire with the system of Colon and Machlis are discussed the rejection of claim 151, and incorporated herein.

As per clam 157, Colon et al. teaches an Internet-networked system with online communication to a computing center from a large number of clinical study investigators at numerous and diverse locations remote from the computing center (see: column 1, lines 36-38).

Colon et al. fails to teach:

--the claimed optional selection by an individual of an electronic consent to an agreement volunteering for consideration as a member of a pool of potential candidates for review and selection for any of the plurality of clinical trials and (ii) at least one entry field for the individual to enter one of medical information and personally identifying information, the individual being the potential candidate;

(i) the individual's on-line electronic consent to the agreement and (ii) at least one of the individual's medical information and personally identifying information;

saving the at least one of the individual's medical information and personally identifying information to a database of individuals available for consideration as potential candidates for any of the plurality of clinical trials; and,

at least one of providing electronic access to the database and providing personally identifying information from the database to representatives of at least two of the plurality of the clinical trials, whereby the appropriate individuals can be recruited for enrollment in a particular clinical trial.

Machlis teaches a medical management company American Oncology Resources, Inc. (AOR) that helps its doctor participating in drug trials using web-based application and databases

(see: paragraph 8). Machlis further teaches that each time (AOR) learns of a new drug trial the information about the trial is entered in the system and patient information stored in the database is scanned for preliminary matches (see: paragraph 10). Machlis also teaches TVisions, Internet consulting firm and working with AOR have developed a database for clinical drug trials. Furthermore, Machlis teaches that the patient can decide if they want to try a new therapy (see: paragraph 11). In addition, Machlis teaches for security and privacy reasons, all information going in and out of the database is encrypted and only a patient initials and identification number are entered into the database which is accessed over the Internet (see: paragraph 12).

One of ordinary skill in art at the time the invention was made would have found it obvious to include (AOR) and TVisions web-based application and databases for drug trials with patient consent as taught by Machlis within the method for managing data used in conducting clinical studies as taught by Colon et al. with the motivation the making the process of linking data about patients and drug tests simple (see: Machlis: paragraph 2). The Examiner considers representatives or companies making their clinical trials available to the database described in Machlis and being informed of matches to their new clinical trial as essentially providing electronic access to representatives of at least two of a plurality of clinical trials in order to encourage recruitment for enrollment of potential candidates.

Colon and Machlis fail to teach the claimed optional selection by an individual of an electronic consent to an agreement volunteering for consideration as a member of a pool of potential candidates for review and selection for any of the plurality of clinical trials and the individual being the potential candidate; and (i) the individual's on-line electronic consent to the agreement;

PR Newswire teaches that Infoseek Corporation home of GO Network agreed to partner with drkoop.com at the Go.com Health Center to provide opportunities for users to enroll in clinical trials from within GO Health (see: abstract). The Examiner considers the user to be the individual and the potential candidate who may optional select to enter the clinical trial.

The obviousness of combining the teachings of PR Newswire with the system of Colon and Machlis are discussed the rejection of claim 151, and incorporated herein.

As per claim 158, Machlis teaches the claimed clinical trials include one of a plurality of potential clinical trials, a plurality of clinical trials in progress, at least one potential clinical trial and at least one clinical trial in progress, and a potential clinical trial and a clinical trial in process. This limitation is met by each time (AOR) learns of a new drug trial the information about the trial is entered in the system and patient information stored in the database is scanned for preliminary matches (see: paragraph 10).

As per claims 187-188, they are rejected for the same reasons set forth in claims 157-158.

As per claim 191, Colon et al. teaches the claimed secure server generates an electronic opt-out form to be displayed on the computer terminal and further comprising receiving the opt-out request on the electronic opt-out form. This limitation is met by the eligibility routine, where an determination is made at the time when patient data is submitted, whether the patient qualifies for the clinical study, and if not, a message is communicated to the clinical study investigator's computer (see: Colon et al.: column 2, lines 5-9). In addition, Colon et al. and Machlis teach the use of Internet server (13, Fig. 1) used to provide Internet network service to all authorized users (see: Colon et al.: column 3, lines 24-44). Furthermore, Colon et al. and Machlis further teach the patient can decide if they want to try a new therapy and for security and privacy reasons, all

information going in and out of the database is encrypted and only a patient initials and identification number are entered into the database which is accessed over the Internet (see: paragraph 11 and 12). The Examiner considers that since the database is accessed over the Internet an authentication is a requirement and the patient has the discretion to opt-out identification information from database since the decision to participate is solely their.

As per claim 192, Colon and Machlis teaches the use of Internet server (13, Fig. 1) used to provide Internet network service to all authorized users (see: Colon et al.: column 3, lines 24-44). Colon and Machlis teach a medical management company American Oncology Resources, Inc. (AOR) that helps its doctor participating in drug trials using web-based application and databases (see: Machlis: paragraph 8). Colon and Machlis further teach that each time (AOR) learns of a new drug trial the information about the trial is entered in the system and patient information stored in the database is scanned for preliminary matches (see: Machlis: paragraph 10). Machlis also teaches TVisions, Internet consulting firm and working with AOR have developed a database for clinical drug trials. Furthermore, Colon and Machlis teach that the patient can decide if they want to try a new therapy (see: Machlis: paragraph 11). In addition, Colon and Machlis teach for security and privacy reasons, all information going in and out of the database is encrypted and only a patient initials and identification number are entered into the database which is accessed over the Internet (see: Machlis: paragraph 12). The Examiner considers representatives or companies making their clinical trials available to the database described in Machlis and being informed of matches to their new clinical trial as essentially providing electronic access to representatives of at least two of a plurality of clinical trials in order to encourage recruitment for enrollment of potential candidates.

Colon and Machlis fail to teach the claimed optional selection by an individual of an electronic consent to an agreement volunteering for consideration as a member of a pool of potential candidates for review and selection for any of the plurality of clinical trials and the individual being the potential candidate; and (i) the individual's on-line electronic consent to the agreement;

PR Newswire teaches that Infoseek Corporation home of GO Network agreed to partner with drkoop.com at the Go.com Health Center to provide opportunities for users to enroll in clinical trials from within GO Health (see: abstract). The Examiner considers the user to be the individual and the potential candidate who may optional select to enter the clinical trial.

The obviousness of combining the teachings of PR Newswire with the system of Colon and Machlis are discussed the rejection of claim 151, and incorporated herein.

As per claim 194, it is rejected for the same reasons set forth in claim 158.

As per clam 195, Colon and Machlis teach the use of Internet server (13, Fig. 1) used to provide Internet network service to all authorized users (see: Colon et al.: column 3, lines 24-44).

In addition, Colon and Machlis teach:

--the claimed receiving from the individual an opt-out request and at least one opt-out identification information, the opt-out identification information being used to authenticate the request is met by the patient deciding if they want to try a new therapy and for security and privacy reasons, all information going in and out of the database is encrypted and only a patient initials and identification number are entered into the database which is accessed over the Internet (see: Machlis: paragraph 11 and 12). The Examiner considers that since the database is

accessed over the Internet an authentication is a requirement and the patient has the discretion to opt-out identification information from database since the decision to participate is solely their.

--the claimed removing the at least one of the individual's medical information and personally identifying information from the database, whereby the individual is remove from consideration as a potential candidate for the clinical trials is met by the patient deciding if they want to try a new therapy and for security and privacy reasons, all information going in and out of the database is encrypted and only a patient initials and identification number are entered into the database which is accessed over the Internet (see: Machlis: paragraph 11 and 12). The Examiner considers that since the patient has the authority to decide whether to participate in the clinical trial, the patient also has the authority to decide whether to remove their personal identifying information and themselves for consideration in any clinical trial.

As per claim 196, it is rejected for the same reasons set forth in claim 191.

As per claim 197, Colon and Machlis teaches the use of Internet server (13, Fig. 1) used to provide Internet network service to all authorized users (see: Colon et al.: column 3, lines 24-44). Colon and Machlis teach a medical management company American Oncology Resources, Inc. (AOR) that helps its doctor participating in drug trials using web-based application and databases (see: Machlis: paragraph 8). Colon and Machlis further teach that each time (AOR) learns of a new drug trial the information about the trial is entered in the system and patient information stored in the database is scanned for preliminary matches (see: Machlis: paragraph 10). Machlis also teaches TVisions, Internet consulting firm and working with AOR have developed a database for clinical drug trials. Furthermore, Colon and Machlis teach that the patient can decide if they want to try a new therapy (see: Machlis: paragraph 11). In addition,

Colon and Machlis teach for security and privacy reasons, all information going in and out of the database is encrypted and only a patient initials and identification number are entered into the database which is accessed over the Internet (see: Machlis: paragraph 12). The Examiner considers representatives or companies making their clinical trials available to the database described in Machlis and being informed of matches to their new clinical trial as essentially providing electronic access to representatives of at least two of a plurality of clinical trials in order to encourage recruitment for enrollment of potential candidates.

Colon and Machlis fail to teach receiving over a network (i) an individual's on-line electronic consent to an agreement volunteering for consideration as a member of a pool of potential candidates for review and selection for any of the plurality of clinical trials and the individual being the potential candidate; and (i) the individual's on-line electronic consent to the agreement;

PR Newswire teaches that Infoseek Corporation home of GO Network agreed to partner with drkoop.com at the Go.com Health Center to provide opportunities for users to enroll in clinical trials from within GO Health (see: abstract). The Examiner considers the user to be the individual who is giving electronic consent within the GO Network.

The obviousness of combining the teachings of PR Newswire with the system of Colon and Machlis are discussed the rejection of claim 151, and incorporated herein.

As per claims 199-201, they are rejected for the same reason set forth in claims 194-196.

As per claim 202, Colon and Machlis teach a medical management company American Oncology Resources, Inc. (AOR) that helps its doctor participating in drug trials using web-based application and databases (see: Machlis: paragraph 8). Colon and Machlis further teach

that each time (AOR) learns of a new drug trial the information about the trial is entered in the system and patient information stored in the database is scanned for preliminary matches (see: Machlis: paragraph 10). Machlis also teaches TVisions, Internet consulting firm and working with AOR have developed a database for clinical drug trials. Furthermore, Colon and Machlis teach that the patient can decide if they want to try a new therapy (see: Machlis: paragraph 11). In addition, Colon and Machlis teach for security and privacy reasons, all information going in and out of the database is encrypted and only a patient initials and identification number are entered into the database which is accessed over the Internet (see: Machlis: paragraph 12). The Examiner considers representatives or companies making their clinical trials available to the database described in Machlis and being informed of matches to their new clinical trial as essentially providing electronic access to representatives of at least two of a plurality of clinical trials in order to encourage recruitment for enrollment of potential candidates.

Colon and Machlis fail to teach receiving over a network (i) an individual's on-line electronic consent to an agreement volunteering for consideration as a member of a pool of potential candidates for review and selection for any of the plurality of clinical trials and the individual being the potential candidate; and (i) the individual's on-line electronic consent to the agreement;

PR Newswire teaches that Infoseek Corporation home of GO Network agreed to partner with drkoop.com at the Go.com Health Center to provide opportunities for users to enroll in clinical trials from within GO Health (see: abstract). The Examiner considers the user to be the individual who is giving electronic consent within the GO Network.

The obviousness of combining the teachings of PR Newswire with the system of Colon and Machlis are discussed the rejection of claim 151, and incorporated herein.

As per claim 203, it is rejected for the same reason set forth in claims 195.

4. Claim 156 is rejected under 35 U.S.C. 103(a) as being unpatentable over Web links cancer patients to drug trials" by Machlis and U.S. Patent No. 6,171,112 to Clark et al. in view of "GO Network ™ and drkoop.com Strike Exclusive $57 Million Cross-Network Partnership" by PR Newswire.

As per claim 156, Machlis teaches a medical management company American Oncology Resources, Inc. (AOR) that helps its doctor participating in drug trials using web-based application and databases (see: paragraph 8). Machlis further teaches that each time (AOR) learns of a new drug trial the information about the trial is entered in the system and patient information stored in the database is scanned for preliminary matches (see: paragraph 10). Machlis also teaches TVisions, Internet consulting firm and working with AOR have developed a database for clinical drug trials. Furthermore, Machlis teaches that the patient can decide if they want to try a new therapy (see: paragraph 11). In addition, Machlis teaches for security and privacy reasons, all information going in and out of the database is encrypted and only a patient initials and identification number are entered into the database which is accessed over the Internet (see: paragraph 12).

Machlis fails teach each record corresponding to individual from who has been received an on-line electronic consent to an agreement volunteering as a potential candidate for the clinical trial.

Clark et al. teaches a method and apparatus for authenticating informed consent for patient that includes providing a means for the patient to input data in the form of answers to questions as well as prompting the patient for electronic signature (see: column 11, lines 66 to column 12, lines 50 and Fig. 17).

One of ordinary skill in the art at the time the invention was made would have found it obvious to include authenticating informed consent for patient as taught by Clark et al. with (AOR) and TVisions web-based application and databases for drug trials with patient consent as taught by Machlis with the motivation of positively affecting the patient-physician relationship by allowing the physician to accomplish more with each patient in less time (see: Clark et al.: column 3, lines 37-40).

Machlis and Clark fail to teach the each record corresponding to individuals being the potential candidate whom is giving electronic consent.

PR Newswire teaches that Infoseek Corporation home of GO Network agreed to partner with drkoop.com at the Go.com Health Center to provide opportunities for users to enroll in clinical trials from within GO Health (see: abstract). The Examiner considers the user to be the individual and the potential candidate.

Therefore, it would have been obvious to a person of ordinary skill in the art at time the invention was made to include using the Internet for user enrollment as taught by PR Newswire with the system as taught by Machlis and Clark with the motivation of giving users across multiple sites reliable health information benefiting from decades of medical experience offered by drkoop.com (see: abstract).

5. Claims 159-180, 186, 189, 193 and 198 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,991,731 to Colon et al., "Web links cancer patients to drug trials" by Machlis and in view of "GO Network™ and drkoop.com Strike Exclusive $57 Million Cross-Network Partnership" by PR Newswire as applied to claim 157 above, and further in view of U.S. Patent No. 6,171,112 to Clark et al.

As per claim 159, Colon et al., Machlis and PR Newswire fail to explicitly teach the claimed agreement is a click wrap consent agreement.

Clark et al. teaches a method and apparatus for authenticating informed consent for patient that includes providing a means for the patient to input data in the form of answers to questions as well as prompting the patient for electronic signature (see: column 11, lines 66 to column 12, lines 50 and Fig. 17).

One of ordinary skill in the art at the time the invention was made would have found it obvious to include authenticating informed consent for patient as taught by Clark et al. with the system as taught by Colon et al., Machlis and PR Newswire with the motivation of positively affecting the patient-physician relationship by allowing the physician to accomplish more with each patient in less time (see: Clark et al.: column 3, lines 37-40).

As per claim 160, Clark et al. teaches the claimed generating an electronic survey form for transmission over a network. This limitation is met by the computer system (17, 18, 19, Fig. 1) with a screen that brings up a form used for entering patient related data (see: column 6, lines 22-30). In addition, the data maybe transferred via the Internet, a dedicated local area network, leased private or semi-private data transmission lines using encryption or other secure means (see: Clark et al.: column 10, lines 54-57).

As per claim 161, Clark et al. teaches the claimed transmitting the electronic survey form in response to receipt of the individual's consent to the agreement. This limitation is met by an individual seeking informed consent and selecting the appropriate survey that requires authentication of the recipient's (see: column 6, lines 33-36). In addition, the data maybe transferred via the Internet, a dedicated local area network, leased private or semi-private data transmission lines using encryption or other secure means (see: Clark et al.: column 10, lines 54-57).

As per claim 162, Colon et al. teaches the claimed electronic survey form comprises at least one of information and medical related questions. This feature is met by the computer system (17, 18, 19, Fig. 1) with a screen that brings up a form used for entering patient related data such as identification, demographics and medical conditions and later transmitted to the study management center (10, Fig. 1) as represented by input block (61, Fig. 5) (see: column 6, lines 22-30).

As per claims 163-165, Colon et al., Machlis and Clark et al. teach a computer system (17, 18, 19, Fig. 1) with a screen that brings up a form used for entering patient related data such as identification, demographics and medical conditions and later transmitted to the study management center (10, Fig. 1) as represented by input block (61, Fig. 5) (see: Colon et al. column 6, lines 22-30). Colon et al and Clark et al. method of obtaining an informed patient consent during a patient session, which includes the answering of questions by the patient and this data is encrypted and transmitted to a central data facility (see: Clark et al.: column 4, lines 31-55). In addition, the data maybe transferred via the Internet, a dedicated local area network, leased private or semi-private data transmission lines using encryption or other secure means

(see: Clark et al.: column 10, lines 54-57). Furthermore, Colon et al. and Clark et al. teach the use of Internet server (13, Fig. 1) used to provide Internet network service to all authorized users (see: Colon et al.: column 3, lines 24-44).

As per claims 166-173, Colon et al., Machlis and Clark et al. teach the use of Internet server (13, Fig. 1) used to provide Internet network service to all authorized users (see: Colon et al.: column 3, lines 24-44). Colon et al., Machlis and Clark et al. also teach a method and apparatus for authenticating informed consent where transferred patient data (706, Fig. 7) is recorded and stored securely at the data facility (702, Fig. 7) using encryption technology. The encryption ensures maximum protection of patient privacy and the security of the network. Encryption is done using standard private/public key system and a decryption key used to restore the encrypted data to original form (see: Clark et al.: column 17, lines 1-18). Colon et al., Machlis and Clark et al. further teach that transferred data from the data facility (702, Fig. 7) to the Virtual Interactive Teaching and Learning (VITAL) Centers is updated to ensure that the information is up-to-date and accurate (see: Clark et al.: column 17, lines 26-30 and Fig. 9). Colon et al., Machlis and Clark et al. also teach that only authorized personnel can access the system to protect the integrity of system by minimizing the chance of intentional or inadvertent corruption of patient information (see: Clark et al.: column 12, lines 58-61). The Examiner considers the authorized personnel accessing the system as the only users providing requests and responses to retrieve data from the memory devices.

As per claim 174, Colon et al., Machlis and Clark et al. teach the claimed authorized individual reviews the encrypted processed data and select the individual as a potential candidate is met by the only authorized personnel accessing the system to protect the integrity of system by

minimizing the chance of intentional or inadvertent corruption of patient information (see: Clark et al.: column 12, lines 58-61), the method comprising:

--the claimed communicating to individual the selection as the potential candidate is met by the user table (48, Fig. 4) that contains contact information related to the user (see: Colon et al.: column 5, lines 17-20).

As per claim 175, Colon teaches the claimed communication comprises one of:

(d) the central office contacting the potential candidate in order to request permission for the authorized individual to contact the potential candidate;

(e) the central office providing the authorized individual with contact information for the potential candidate and the authorized individual communicating with the potential candidate; and

(f) the central office communicating to the potential candidate the selection and providing contact information for the potential candidate to initiate contact with the one of the authorized individual and an employee of the clinical trial associated with the authorized individual.

Colon et al. teach the claimed (e) the central office providing the authorized individual with contact information for the potential candidate and the authorized individual communicating with the potential candidate. This limitation is met by the user table (48, Fig. 4) that contains contact information related to the user (see: column 5, lines 17-20). In addition, Colon et al. teaches a permission table (49, Fig. 4) that contains flags that are used to authorize a user for access to information about sites, regions and study level information (see: column 5, lines 17-25).

As per claim 176, Colon et al., Machlis and Clark et al. teach the claimed generating a certificate to verify transmission between the individual and secure server. This limitation is met by the patient being asked sign an informed consent electronically and acknowledge of the consent is printed (see: Clark et al.: column 4, lines 19-22). In addition, Colon et al. and Clark et al. teach the use of Internet server (13, Fig. 1) used to provide Internet network service to all authorized users (see: Colon et al.: column 3, lines 24-44).

As per claim 177, Colon et al. teaches the claimed computer terminal employs a web browser capable of supporting a secure socket layer protocol (see: column 3, lines 39-41).

As per claim 178, Colon et al., Machlis and Clark et al. teach the claimed ensuring that decrypted information stored at said secure server is not accessed by unauthorized personnel. This feature is met by the method and apparatus for authenticating informed consent where transferred patient data (706, Fig. 7) is recorded and stored securely at the data facility (702, Fig. 7) using encryption technology. The encryption ensures maximum protection of patient privacy and the security of the network. Encryption is done using standard private/public key system and a decryption key used to restore the encrypted data to original form (see: Clark et al.: column 17, lines 1-18). Clark et al. also teaches that only authorized personnel can access the system to protect the integrity of system by minimizing the chance of intentional or inadvertent corruption of patient information (see: Clark et al.: column 12, lines 58-61). In addition, Colon et al. and Clark et al. teach the use of Internet server (13, Fig. 1) used to provide Internet network service to all authorized users (see: Colon et al.: column 3, lines 24-44).

As per claim 179, Colon et al. and Clark et al. teaches the claimed ensuring step comprises at least one of limiting access to said secure server to a minimum number of

authorized personnel and devising and implementing procedures to ensure that only authorized personnel gain access to the decrypted data. This feature is met by allowing only authorized personnel to access the system to protect the integrity of system by minimizing the chance of intentional or inadvertent corruption of patient information (see: Clark et al.: column 12, lines 58-61). In addition, Colon et al. and Clark et al. teach the use of Internet server (13, Fig. 1) used to provide Internet network service to all authorized users (see: Colon et al.: column 3, lines 24-44).

As per claim 180, Machlis teaches:

--the claimed receiving from the individual an opt-out request and at least one opt-out identification information, the opt-out identification information being used to authenticate the request is met by the patient deciding if they want to try a new therapy and for security and privacy reasons, all information going in and out of the database is encrypted and only a patient initials and identification number are entered into the database which is accessed over the Internet (see: paragraph 11 and 12). The Examiner considers that since the database is accessed over the Internet an authentication is a requirement and the patient has the discretion to opt-out identification information from database since the decision to participate is solely their.

--the claimed removing the at least one of the individual's medical information and personally identifying information from the database, whereby the individual is remove from consideration as a potential candidate for the clinical trials is met by the patient deciding if they want to try a new therapy and for security and privacy reasons, all information going in and out of the database is encrypted and only a patient initials and identification number are entered into the database which is accessed over the Internet (see: paragraph 11 and 12). The Examiner

considers that since the patient has the authority to decide whether to participate in the clinical trial, the patient also has the authority to decide whether to remove their personal identifying information and themselves for consideration in any clinical trial.

As per claim 186, Colon et al. and Machlis teach the claimed secure server generates an electronic opt-out form to be displayed on the computer terminal and further comprising receiving the opt-out request on the electronic opt-out form. This limitation is met by the eligibility routine, where an determination is made at the time when patient data is submitted, whether the patient qualifies for the clinical study, and if not, a message is communicated to the clinical study investigator's computer (see: Colon et al.: column 2, lines 5-9). In addition, Colon et al. and Machlis teach the use of Internet server (13, Fig. 1) used to provide Internet network service to all authorized users (see: Colon et al.: column 3, lines 24-44). Furthermore, Colon et al. and Machlis further teach the patient can decide if they want to try a new therapy and for security and privacy reasons, all information going in and out of the database is encrypted and only a patient initials and identification number are entered into the database which is accessed over the Internet (see: paragraph 11 and 12). The Examiner considers that since the database is accessed over the Internet an authentication is a requirement and the patient has the discretion to opt-out identification information from database since the decision to participate is solely their.

As per claim 189, it is rejected for the same reasons set forth in claims 180.

As per claim 193, Colon et al., Machlis and PR Newswire fail to teach the claimed personally identifying information comprises one of name, address, telephone number, e-mail address and name with birth date and the medical information comprises medical data relevant to being selected as a candidate for one of a potential clinical trial and a clinical trial in progress.

Clark et al. teaches a method and apparatus for authenticating informed consent for patient that includes providing a means for the patient to input data in the form of answers to questions as well as prompting the patient for electronic signature (see: Clark: column 11, lines 66 to column 12, lines 50). The Examiner considers using a name for the electronic signature, which is unique to each person, as example of personally identifying information. In addition, Colon et al., Machlis and Clark et al. teach computer system (17, 18, 19, Fig. 1) with a screen that brings up a form used for entering patient related data such as identification, demographics and medical conditions and later transmitted to the study management center (10, Fig. 1) as represented by input block (61, Fig. 5) (see: Colon et al.: column 6, lines 22-30).

The motivation to combining the teachings of Clark et al. within the system as taught by Colon et al., Machlis and PR Newswire are discussed in rejection of claim 159, and incorporated herein.

As per claim 198, it is rejected for the same reason set forth in claims 193.

6. Claim 181 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,991,731 to Colon et al., "Web links cancer patients to drug trials" by Machlis, "GO Network™ and drkoop.com Strike Exclusive $57 Million Cross-Network Partnership" by PR Newswire and U.S. Patent No. 6,171,112 to Clark et al. as applied to claim 157 above, and further in view of Official Notice.

As per claim 181, Colon et al., Machlis, PR Newswire, and Clark fail to teach the claimed agreement satisfies all federal, state, and local rules, ordinances and regulations.

However, it is well known in the computer field that electronic agreements or contracts use and follow all federal, state, and local rules, ordinances and regulations with regard to the

dissemination of medical, health and personally identifying information. Therefore, it would have been obvious a person of ordinary skill in the art at the time the invention was made to include an electronic agreement that satisfies all federal, state, and local rules, ordinances and regulations with regard to the dissemination of medical, health and personally identifying information with the combined system of Colon et al., Machlis, PR Newswire, and Clark with the motivation of avoiding the any negligent and malpractice litigation caused by not stating and following all federal, state, and local rules, ordinances and regulations.

7. Claims 182-183 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,991,731 to Colon et al., "Web links cancer patients to drug trials" by Machlis, "GO Network™ and drkoop.com Strike Exclusive $57 Million Cross-Network Partnership" by PR Newswire and U.S. Patent No. 6,171,112 to Clark et al. as applied to claim 169 above and in view of U.S. Patent No. 6,272,470 to Teshima.

As per claims 182-183, Colon et al., Machlis, PR Newswire and Clark et al. teach method and apparatus for authenticating informed consent where transferred patient data (706, Fig. 7) is recorded and stored securely at the data facility (702, Fig. 7) using encryption technology. The encryption ensures maximum protection of patient privacy and the security of the network. Encryption is done using standard private/public key system and a decryption key used to restore the encrypted data to original form (see: Clark et al.: column 17, lines 1-18).

Colon et al., Machlis and Clark et al. fail to explicitly teach shareware encryption protocol that is Pretty Good Privacy.

Teshima teaches an electronic clinical recording system that includes encrypting/decrypting software referred to as PGP (Pretty Good Privacy) using public keys (see: column 15, lines 34-41).

One of ordinary skill in the art at the time the invention was made would have found it obvious to include encrypting/decrypting software such as PGP (Pretty Good Privacy) as taught by Teshima with the system of Colon et al., Machlis, PR Newswire and Clark et al. with the motivation of preventing unauthorized access to valuable data thereby ensuring the privacy and security of the information.

8. Claims 184-185 and 190 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,991,731 to Colon et al., "Web links cancer patients to drug trials" by Machlis, "GO Network™ and drkoop.com Strike Exclusive $57 Million Cross-Network Partnership" by PR Newswire and U.S. Patent No. 6,171,112 to Clark et al. as applied to claim 173 above, and further in view of Official Notice.

As per claim 184, Colon et al., Machlis, PR Newswire and Clark et al. fail to explicitly teach the claimed decryption of the retrieved encrypted information from the second memory device is performed using encryption keys stored on a disk kept under physical surveillance.

However, Colon et al., Colon et al., Machlis, PR Newswire and Clark et al. teach method and apparatus for authenticating informed consent where transferred patient data (706, Fig. 7) is recorded and stored securely at the data facility (702, Fig. 7) using encryption technology. The encryption ensures maximum protection of patient privacy and the security of the network. Encryption is done using standard private/public key system and a decryption key used to restore the encrypted data to original form (see: Clark et al.: column 17, lines 1-18). It is well known in

the computer industry for a person to be possession of a disk used to store standard private/public encryption and decryption keys as described by Colon et al., Machlis, PR Newswire and Clark et al. Therefore, it would have been obvious to a person of ordinary skill in the art the time the invention was made to include storing a encryption keys on a disk kept under physical surveillance with in the system of Colon et al., Machlis, PR Newswire and Clark et al. with the motivation of preventing unauthorized access to valuable data thereby ensuring the privacy and security of the information.

As per claim 185, Clark et al. teaches the claimed personally identifying information is one of name, address, telephone number, e-mail address and name with birth date. This limitation is met by the method and apparatus for authenticating informed consent for patient that includes providing a means for the patient to input data in the form of answers to questions as well as prompting the patient for electronic signature (see: column 11, lines 66 to column 12, lines 50). The Examiner considers using a name for the electronic signature, which is unique to each person, as example of personally identifying information.

As per claim 190, Colon et al., Machlis and PR Newswire fail to teach the claimed personally identifying information is one of name, address, telephone number, e-mail address and name with birth date.

Clark et al. teaches a method and apparatus for authenticating informed consent for patient that includes providing a means for the patient to input data in the form of answers to questions as well as prompting the patient for electronic signature (see: column 11, lines 66 to column 12, lines 50). The Examiner considers using a name for the electronic signature, which is unique to each person, as example of personally identifying information.

One of ordinary skill in the art at the time the invention was made would have found it obvious to include authenticating informed consent for patient as taught by Clark et al. with the system as taught by Colon et al., Machlis and PR Newswire with the motivation of positively affecting the patient-physician relationship by allowing the physician to accomplish more with each patient in less time (see: Clark et al.: column 3, lines 37-40).

***Response to Arguments***

9. Applicant's arguments filed 9/13/05 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 9/13/04.

In response to the Applicant's arguments, it is respectfully submitted that the Examiner has applied prior art to previously presented claims 151-156 and newly added claims 157-203 at the present time. As such, Applicant's remarks with regard to Colon, Clark Machlis, PR Newswire and Teshima to the claims 151-203 are addressed in the above Office Action.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Morgan whose telephone number is (571) 272-6773. The examiner can normally be reached on 8:30 a.m. - 5:00 p.m. Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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